

Applicants: Ziv Sandalon et al.
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REMARKS

Claims 1-2, 4-13, 16-20, 22-37, 41-43 and 45-47 are pending in the subject application. Applicants note that the Examiner has allowed claims 29-34 and 47. Applicants have amended claims 1, 7, 9, 13, 22, 25, 26, 35 and 43. Support for these amendments may be found inter alia in the specification as follows: for the term "naked" recited in claims 1, 7, 9, 13, 22, 25, 26, 35 and 43: page 34, line 7. The remaining changes to the claims merely introduce minor grammatical and format changes. In making these amendments, applicants neither concede the correctness of the Examiner's rejections, nor abandon their right to pursue in a continuing application embodiments of the instant invention no longer claimed in this application. These amendments do not involve any issue of new matter. Therefore, entry of these amendments is respectfully requested such that claims 1-2, 4-13, 16-20, 22-37, 41-43 and 45-47 will still be pending.

Rejection

The March 31, 2004 Advisory Action indicates that the Communication filed March 15, 2004 has been considered but is not deemed to place the application in condition for allowance. The Examiner stated that applicants reiterate that page 34 of the specification teaches that *in vitro* packaging of nucleic acids in SV40 does not involve nucleoprotein formation. The Examiner noted that the specification does not provide explicit support for the claimed language. The Examiner stated that the section of the specification cited by

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applicants does not support the amended claims because it only recites packaging of "supercoiled DNA" in vitro which is predicted to relieve packaging problems in vitro created by formation of nucleoproteins and that LCR elements do not interfere with in vitro packaging because these LCR elements only form "higher order nucleoprotein structures" in vivo. The Examiner stated that while the specification does recite "...in vitro packaging utilizes naked DNA, prepared in E.coli...", this limitation does not provide support for claims which recite any "recombinant nucleic acid" constituent (claim 18, this reads on DNA, RNA, etc.) or antisense RNA, ribozyme RNA, purified exogenous RNA, etc. (claims 1 and 35) as the nucleic acid constituents because the specification does not teach these constituents (RNA, ribozymes, antisense molecules, etc.) in the context of their not being nucleoproteins. The Examiner stated that in summary, the only non-nucleoprotein which the specification provides support for involves "naked DNA, prepared in E.coli".

The Examiner noted that in the previous office action, he neglected to note that claim 47 was also allowed.

During the May 13, 2004 telephone interview between Examiner Guzo and Ms. Marucci, the Examiner stated that amending the claims by adding the term "naked" before "DNA" and deleting the phrase "not a nucleoprotein", where applicable, would obviate all outstanding rejections of the claims.

Applicants note that the claims have been amended hereinabove as recommended by the Examiner during the May 13, 2004

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telephone interview. Specifically, applicants have hereinabove amended the claims such that the phrase "not a nucleoprotein" has been deleted and the term "naked" has been added to describe the DNA constituent.

Applicants contend that these amendments obviate the outstanding rejection and respectfully request that the Examiner reconsider and withdraw this ground of rejection. Applicants maintain that the pending claims are in condition for allowance, and allowance is respectfully requested.

Summary

In view of the amendments and remarks made herein, applicants maintain that the claims pending in this application are in condition for allowance. Accordingly, allowance is respectfully requested.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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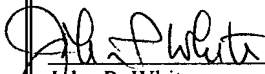
No fee, other than the enclosed \$210.00 fee for a two-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

 6/10/04
John P. White Date
Reg. No. 28,678